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10/080,877	02/22/2002	Ronald A. Schachar	PRES06-00181	9828

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Dallas, TX 75380

EXAMINER
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PANTUCK, BRADFORD C

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/080,877

Applicant(s)

SCHACHAR ET AL. ED

Examiner

Bradford C Pantuck

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on December 8, 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 22-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 31-61 is/are rejected.
- 7) ☒ Claim(s) 10-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims 39 and 51 are objected to because of the following informalities: The word "of" is misspelled in line 2 of both claims. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,522,829 to Michalos. Regarding Claim 1, Michalos discloses a surgical tool with a blade (22) capable of cutting the sclera of the eye [Fig. 1].
3. Regarding Claim 6, Michalos discloses a first drive shaft (26) coupled to base housing (12/14). Second drive shaft (20) is coupled (attached) to first drive shaft (26). Third drive shaft (28) is mounted on the drive shaft housing (12/14) at a 90-degree angle with respect to the central axis of the drive shaft housing. Surgical blade (22) is coupled to the third drive shaft (28).
4. Regarding Claims 7 and 8, Michalos discloses a device having a line, which will inevitably form the junction between section (14) and section (16) of the housing [see Attachment #1]. This line is *capable of being used as a reference line* during the surgery to guide him in cutting the eyeball.

5. Regarding Claim 9, Michalos discloses a rotatable support arm (32) with a first end coupled to drive shaft (28) and a second end coupled to blade (22) [Column 6, lines 10-14; Figure 1]. Support arm (32) rotates with the blade. The blade (22) has a curved end [Fig. 1] and another end coupled to support arm (32). The blade is quite sharp and is capable of being used to cut an incision having the specifications mentioned by Applicant. As noted by Michalos, the depth and size of the incision will correspond to the skill and desire of the surgeon [Column 8, lines 43-52].

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 and 31-61 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,328,747 B1 to Nun. Regarding Claims 1, 31, and 56, Nun discloses a surgical tool for making an incision in the eye and includes a surgical blade (246) [Fig. 18] capable of making an incision having the form of a pocket capable of receiving a prosthesis [Column 15, lines 61-63]. Surgical blade (70) is also capable of such a purpose [Fig. 14; Column 10, lines 42-52]. An incision is considered to be merely a cut or hole in body tissue. Nun discloses putting a prosthesis into the eye [Column 16, lines 6-8].
7. Regarding Claim 2, blade (70) is curved [Fig. 14; Column 10, lines 46-50] and the user of the device can cut as small or as big incision as the user desires. Particularly, the blade 246 (when it is not spinning) *is capable of being used* to puncture the sclera and form a very small, linear incision in the sclera.

8. Regarding Claims 3, 32-34, 42-43, 48-50, 54, 55, and 57-61, Nun discloses a first drive shaft (248), a drive motor (206), and a control cable (not shown) [Fig. 16; Column 17, lines 23-26 and 48-51; Column 12, lines 1-3]. Drills are generally capable of bi-directional spinning. Electric power comes from an external power source (i.e., electricity) so there would need to be a receptacle to allow the electricity to flow into the motor [Column 17, lines 48-54].
9. Regarding Claims 4, 35-38, 44, and 45, the surgeon can adjust the speed of the motor using controls [Column 15, lines 36-40].
10. Regarding Claims 5, 39-41, and 51, Nun discloses a foot switch for controlling the speed of the blade [Column 20, lines 59-62]. Foot switches are capable of receiving control signals from the surgeon, such as depressing the pedal in order to tell the motor to rotate faster.
11. Regarding Claims 46, 47, 52, and 53, Nun's device is capable of rotating the blade once (in a controlled way) in order to make an incision.

*Allowable Subject Matter*

12. Claims 10-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Response to Arguments***

14. Applicant's arguments filed December 8, 2004 have been fully considered but they are not persuasive. Regarding the rejection with U.S. Patent No. 5,522,829 to Michalos, Examiner maintains that Michalos discloses each and every feature of the invention as claimed. Applicant claims a surgical tool having a surgical blade, meant for a particular intended use. Michalos indisputably discloses a surgical tool having a blade (22). That is, the prior art clearly discloses *all of the claimed structure*.

Regarding the intended use,

capable of being moved by said surgical tool through said scleral tissue of said eye to make an incision having the form of a scleral pocket that is capable of receiving a scleral prosthesis.

15. Examiner maintains that it is a matter quite *dependent on the skill of the surgeon*, whether or not the blade (22) of Fig. 1 or the blade (64) of Fig. 3 can be used to form a scleral pocket of the dimensions specified by the Applicant. However, regarding

Claim 1, Applicant merely claims that the surgical tool is capable of forming a scleral pocket. Examiner must interpret “scleral pocket” in light of the specification, but in the broadest sense, a scleral pocket is a merely *a pocket formed in scleral tissue*. A *pocket*, as defined by Merriam Webster dictionary is, “a cavity containing a deposit (as of gold, water, or gas).” Michalos discloses using his blade to form a microscopic incision in the sclera of the human eye [Column 5, lines 19-30]. Such an incision is inherently capable of receiving an implant. Applicant’s argument [REMARKS, page 21, lines 5-10] that his device is more precise than Michalos’ device is a matter of opinion, and is not a patentable distinction.

16. Regarding the rejection under U.S. Patent No. 6,328,747 B1 to Nun, Examiner maintains that Nun discloses each and every feature of the claimed invention. Regarding Applicant’s argument that Nun’s prosthesis is not a scleral prosthesis [REMARKS, page 21, lines 19 and 20], Examiner queries, what is the difference between the two prostheses? What structure does Applicant’s prosthesis have that Nun’s does not? What structure does Applicant’s cutter have that Nun’s cutter does not?
17. Recommendations: Examiner recommends that Applicant focus more on the structure of the invention, i.e. the sickle shape of the cutting blade, the rotational movement of the tip of the blade (\*relative to the rest of the device) to punch into tissue, the pointed tip of the cutting blade, along with the patentable material set forth in claims 10-21.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (571) 272-4701. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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January 18, 2005